

**PATENT**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**APPLICANT:** James E. Price

**GROUP ART UNIT:** 3772

**SERIAL NO.:** 10/568,131

**EXAMINER:** Lewis, Kim M.

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**Commissioner of Patents**  
**P.O. Box 1450**  
**Alexandria, VA 22313-1450**

**APPELLANT'S BRIEF (37 CFR 41.37)**

This brief is in furtherance of the Notice of Appeal filed in this case on April 17, 2008.

The fees required under § 41.20(b)(2) and any required petition for extension of time for filing this brief and fees therefor are dealt with in the accompanying TRANSMITTAL OF APPEAL BRIEF.

This brief contains these items under the following headings and in the order set forth below (37 CFR 41.37 and MPEP 1208):

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED SUBJECT MATTER
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII. ARGUMENT: REJECTIONS UNDER 35 U.S.C. §103
- VIII. CLAIMS APPENDIX
- IX. EVIDENCE APPENDIX
- X. RELATED PROCEEDINGS APPENDIX

I hereby certify that this correspondence is being transmitted via EFS-WEB to the United States Patent and Trademark Office on the date below

  
Scott A. Smith, Reg. No. 46,067

7-17-08  
Date of Signature

**I. REAL PARTY IN INTEREST (37 C.F.R. 41.37 (c)(1)(i))**

Not applicable.

**II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. 41.37 (c)(1)(ii))**

With respect to other appeals or interferences that will directly affect, or be directly affected by, or having a bearing on the Board's decision in this appeal:

**A.** [ ☒ ] there are no such appeals or interferences.

**B.** [ ☐ ] there are as follows:

**III. STATUS OF CLAIMS (37 CFR 41.37 (c)(1)(iii))**

The status of the claims in this application are as follows:

**A. TOTAL NUMBER OF CLAIMS IN APPLICATION**

Claims in the application are: **11**

**B. STATUS OF ALL THE CLAIMS**

(If there are no claims in a category indicated: NONE)

1. Claims cancelled: **None**
2. Claims withdrawn from consideration but not cancelled: **None**
3. Claims pending: **1-11**
4. Claims allowed: **None**
5. Claims rejected: **1-11**

**C. CLAIMS ON APPEAL**

The claims on appeal are: **1-11**

**IV. STATUS OF AMENDMENTS (37 CFR 41.37 (c)(1)(iv))**

There are presently no pending unentered amendments in the above identified application.

**V. SUMMARY CLAIMED SUBJECT MATTER (37 CFR 41.37 (c)(1)(v))**

1. A cosmetic bandage (1) comprising: (p.4, ll. 4-7, Figs. 1, and 7-9)

a transparent backing layer (2) having a top side (10) and a bottom side (11); (p.4, ll. 8-12; p. 5, l. 2,; Figs. 1, and 8-9)

a transparent adhesive layer (5) applied to the bottom side (11) of the transparent backing layer (2); (p.4, l. 9, Figs. 1, and 8-9)

an absorbent pad (3) having a bottom side (21) and a top side (20), the top having a non-toxic pigmented composition applied to it so as to be derma matching and having a melanin likeness and appearance so as to substantially match human skin tones and colors, the top side of the absorbent pad (3) being attached to the bottom side of said backing layer (2) so as to be visible therethrough; and (p.4, ll. 20-31; p.5, ll. 1-30; p.6 ll. 1-11, Figs. 1-9)

at least one removable strip (4) applied to the bottom side (11) of said backing layer (2) and said pad (3). (p.4, ll. 24-25, Fig. 1)

7. A method of constructing a cosmetic bandage (1) comprising: (p.6, ll. 3-11, Figs. 1 and 6)

forming an absorbent pad (3) having a bottom side (21) and a top side (20); (p.6, ll. 3-11, Figs. 1 and 6)

applying a non-toxic pigment to the top side (20) of the pad (3); and attaching the pigmented top side of the pad (3) to a transparent backing layer (2). (p.6, ll. 3-11, Figs. 1 and 6)

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

(37 CFR 41.37 (c)(1)(vi))

The following grounds of rejection are requested to be reviewed on appeal:

The Examiner's conclusion that Claims 1-11 are obvious under 35 U.S.C. §103 a over U.S. Pat. No. 3,687,136 issued to *Carmody* (hereafter referred to as "*Carmody*") in view of U.S. Pat. No. 5,120,325 issued to *Dow* (hereafter referred to as "*Dow*"), and U.S. Pat. No. 2,905,174 issued to *Smith* (hereafter referred to as "*Smith*").

## **VII. ARGUMENTS - REJECTIONS UNDER 35 U.S.C. § 103 (CFR 1.192(c)(8)(iv))**

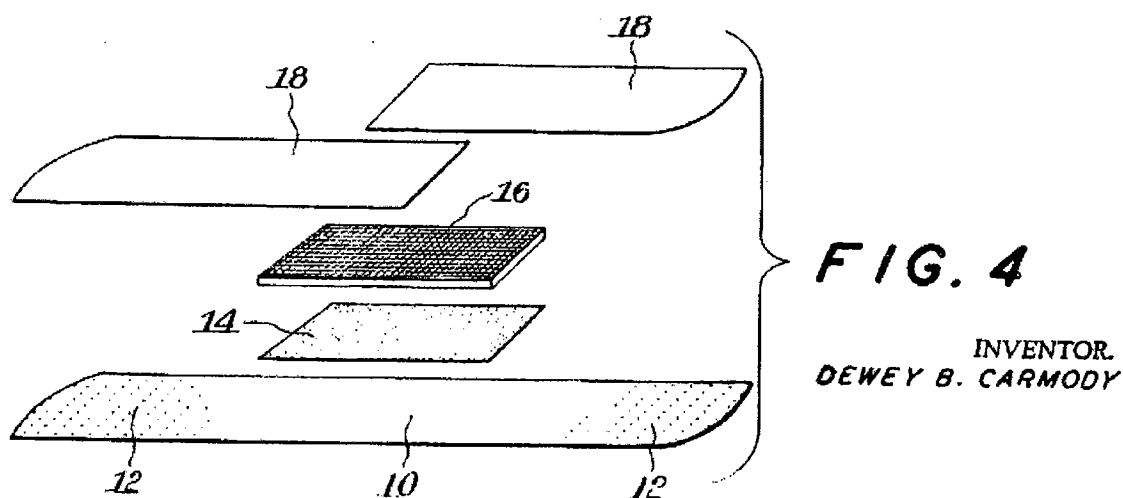
### **A. Introduction and Overview**

The Examiner rejected Claims 1-11 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 3,687,136 issued to *Carmody* in view of U.S. Pat. No. 5,120,325 issued to *Dow*, and U.S. Pat. No. 2,905,174 issued to *Smith*. The Appellant respectfully disagrees with the Examiner's conclusion and suggests that the Examiner has not shown that all the elements of any of claims 1-11 are found in the cited references. Rather, the Examiner has improperly constructed a rejection with hindsight based merely on the road map provided by Appellant's specification. In addition, the Examiner has failed to provide a proper rational as to why a person of ordinary skill in the art would have combined the references as the manner claimed.

### **B. Discussion of the References**

#### **1. U.S. Pat. No. 3,687,136 to *Carmody*.**

As best understood, *Carmody* discloses a bandage having a flexible thin plastic strip (10) with an pressure sensitive adhesive (12) on opposite ends for receiving backing strips (18). (Col. 2, ll. 1-27). A second flexible thin plastic strip (14) is colored to a suitable color and secured to the inner surface of the first plastic strip (10). *Id.* An absorbent pad (16) secures to the second plastic strip (14). *Id.* As a result, the colored plastic strip (14) is disposed between the first plastic strip (10) and the pad (16). *Id.* FIG. 4 of *Carmody* is reproduced below:

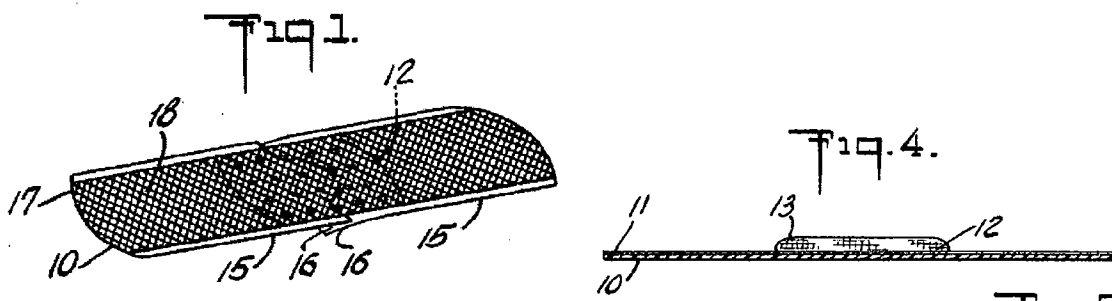


**2. U.S. Pat. No. 5,120,325 to Dow.**

*Dow* discloses a bandage comprising a non-transparent backing layer having a bottom side and a top side. (Col. 2, ll. 10-22). An adhesive layer applies to the bottom side for attaching an absorbent pad. *Id.* A pigmented composition coats or embeds into the top side of the backing layer. *Id.* The pigmented composition comprises from about 0.5% to about 98% by solid weight at least one melanin pigment. (Col. 3, ll. 66-68). None of the pigment composition coats or embeds into the absorbent pad. *Id.* *Dow* does not disclose any Figures.

**3. U.S. Pat. No. 2,905,174 to Smith.**

*Smith* discloses a bandage with a transparent backing (10) coated on one side with a transparent adhesive (11). (Col. 3, ll. 33-36). An absorbent pad (12) secures to the center of the backing (10) with adhesive (11). (Col. 3, ll. 36-38). Facing strips (15) secure to the remaining adhesive and extend to cover the pad (12). (Col. 3, ll. 41-46). A plurality of flesh-colored markings (17) are provided on the transparent backing (10) to hide the pad (12) from view. (Col. 3, ll. 60-62). FIGS. 1 and 4 are reproduced below:



### C. Requirements For A *Prima Facie* Case Of Obviousness

As the Federal Circuit has admonished, “virtually all [inventions] are combinations of old elements.” *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332 (Fed. Cir. 2005). Here, the Examiner apparently has attempted to find every individual element of the claimed invention in the prior art. However, “The mere fact that elements of [an invention] may be found in various [references] does not necessarily negate invention.” *In re McKenna*, 40 C.C.P.A. 937, 203 F.2d 717, 721, 97 U.S.P.Q. (BNA) 348, 351 (CCPA 1953).

To counter this propensity to construct an obviousness rejection, the suggestion to combine the art stands as a safeguard against hindsight analysis and rote application of the legal test for obviousness. Consequently, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the

reasonable expectation of success must both be found in the prior art, not in Appellant's disclosure.” M.P.E.P. § 2143. The recent *KSR* decision has not altered these requirements.<sup>1</sup>

As outlined in the Examination Guidelines of Federal Register, Vol. 72, No. 195, p. 57534 (October 10, 2007), the Supreme Court in the *KSR* decision reaffirmed the framework for determining obviousness under 35 U.S.C. §103(a) as set forth in *Graham v. John Deere Co.*<sup>2</sup> Under the *Graham* decision, this framework include:

- (a) determining the scope and contents of the prior art;
- (b) ascertaining the differences between the prior art and the claims in issue; and
- (c) resolving the level of ordinary skill in the pertinent art.<sup>3</sup>

As noted in the Examination Guidelines, the *KSR* Court “recognized that a showing of ‘teaching, suggestion, or motivation’ to combine prior art to meet the claimed subject matter could provide a helpful insight in determining whether the claimed subject matter is obvious under 35 U.S.C. 103(a).”<sup>4</sup> As further outlined in the Examination Guidelines, the *KRS* Court noted that the “analysis supporting a rejection under 35 U.S.C. § 103(a) should be made explicit and that it was ‘important to identify a reason that would have prompted a person of ordinary skill in the relevant filed to combine the [prior art] element’” in the manner claimed. The Court specifically stated:

“Often, it will be necessary ...to look at interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art,

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<sup>1</sup> See *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, 82 USPQ2d 1385 (2007).

<sup>2</sup> See 383 U.S. 1 (1966).

<sup>3</sup> See *Graham v. John Deere*, 383 U.S. 1, 17-18 (1966).

<sup>4</sup> Federal Register, Vol. 72, No. 195, p. 57534 (October 10, 2007)(emphasis added).

all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, the analysis should be made explicit.” *KSR*, slip op. at 14.

The Examination Guidelines conclude in its analysis of the *KSR* decision that “in formulating a rejection under U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed”. As the Federal Circuit has found, “a flexible TSM test remains the primary guarantor against a non-statutory hindsight analysis.” *Ortho-McNeil Pharmaceutical, Inc. v. Mylan Laboratories, Inc.*, \_\_\_ F.3d \_\_\_, (Docket No. 2007-1223, Fed. Cir. Decided March 31, 2008 at page 11) (citing *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007)(“[A]s the Supreme Court suggests, a flexible approach to the TSM test prevents hindsight and focuses on evidence before the time of the invention.”)). The *Ortho* court states that the “TSM test, flexibly applied, merely assures that the obviousness test proceeds on the basis of evidence – teachings, suggestions (a tellingly broad term), or motivations (an equally broad term) that arise before the time of the invention as the statute requires.” *Id.*

35 U.S.C 103(a) still requires that “[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”(emphasis added). Appellant respectfully suggests that the Examiner has disregarded the “subject matter as a whole” language



of the statute. Nothing in the art of record shows describes or even vaguely intimates the “subject matter as a whole” of Appellant’s structural combination set forth in the claims 1-11. Rather, apparently using Appellant’s specification as a guide, the Examiner has improperly constructed the rejection element by element. Furthermore, under this improper construction, the Examiner’s rejections are silent as to why a person of ordinary skill in the art would have combined the references as the manner claimed.

**C. Claims 1-11 Are Patentable Over The *Carmody*, *Dow*, and *Smith* Patents.**

There is at least one element specified in independent claims 1 and 7 that are not suggested, disclosed, or claimed in *Carmody*, *Smith*, or *Dow*. Specifically, none of the cited references disclose “an absorbent pad having a bottom side and a top side, the top having a non-toxic pigmented composition applied to it,” or the step of “applying a non-toxic pigment to the top side of the pad”.

In her rejection of Claims 1-11, the Examiner asserts that *Carmody* shows a cosmetic bandage having a transparent backing (10), a pressure sensitive adhesive (12), a pad (16) and a pigmented plastic strip, which lays on top of the pad (16). The Examiner reluctantly acknowledges that *Carmody* does not disclose “an absorbent pad” with a “top having a non-toxic pigmented composition applied to it”. (See Office Action 10/19/2007, p. 3-4). However, the Examiner contends that the pigmented plastic strip of *Carmody* is an equivalent element to the pigmented composition of claims 1-11. *Id.* In support of this contention, the Examiner makes the contradictory statement, “[W]hile the ‘pigmented plastic strip’ of *Carmody* is different from the pigmented composition disclosed in the specification, the pigmented plastic strip is still a pigmented composition that is applied to absorbent pad (16).” Further, the Examiner contends

that, “While applicant’s claims do not require a pigmented plastic strip, an equivalent element, *e.g.* the pigmented composition is used to accomplish the function of matching the skin tone of the user. Thus, the pigmented composition is substituted for the pigmented plastic strip.”

However, this rationale is faulty because the Examiner has not shown that the equivalency of a pigmented plastic strip and a pigment composition applied to a pad is recognized in the art. The Examiner’s comments are merely conclusory statements, which are not sufficient to show a *prima facie* case of obviousness. “To facilitate review, this analysis should be made explicit. Rejections on obviousness cannot be sustained by mere conclusory statements; instead there must be some articulated reasoning with some rationale underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007) citing *In re Kahn*, 441 F.3d 977, 988 (C.A.Fed.2006).

As noted in MPEP 2144.06, “In order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant’s disclosure or the mere fact that the components at issue are functional or mechanical equivalents.” *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958). Nothing in the cited references discloses or suggests the equivalency of a pigmented plastic strip with a pigmented composition applied to a pad. Here, the invention of claim 1 and claim 7 has eliminated the “pigmented plastic strip”, while maintaining the function of matching the skin tone of the user. “Note that the omission of an element and retention of its function is an indicia of unobviousness.” *See* MPEP 2144.04; also *In re Eagle*, 359 F.2d 896 (CCPA).

Moreover, neither *Smith* or *Dow* suggest or disclose a pad with applied pigment or the step of applying pigment to a pad. The Examiner also admits that *Carmody* does not disclose a

*transparent* adhesive or a *non-toxic* pigment. Instead, the Examiner cites *Smith* as teaching a bandages with pigment therein with transparent adhesive. Further, the Examiner cites *Dow* as teaching a color matched adhesive bandage having a non-toxic pigment. Without providing any proper rationale, the Examiner concludes that it would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the bandage of *Carmody* with a transparent pressure sensitive adhesive as taught by *Smith* and a non-toxic pigment as taught by *Dow*. The MPEP states,

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990).

MPEP § 2143.03.

In fact, *Smith* teaches away from such a combination by discouraging the use of transparent backing. See *Ted Air, Inc. v. Denso Manufacturing Michigan, Inc.*, 192 F.3d 1353 (Fed. Cir. 1999) (“There is no suggestion to combine...if a reference teaches away from its combination with another source...”) *Smith* teaches that, “However, with a transparent backing, the unattractive back portion of the pad is clearly visible. Also, when the pad becomes soiled, for example, with wound exudate, the solid pad is clearly visible through the transparent backing, presenting an unsightly and unattractive appearance.” Instead, *Smith* teaches the use of a pigmented backing, “provided with a plurality of flesh-colored markings”. (Col. 3, lines 47-48). Likewise, *Dow* teaches, “It is critical to this invention that a non-toxic, pigmented composition is coated onto or embedded into the top side of the backing layer...” (Emphasis added)(Col. 3, lines 12-14).

As noted above, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed. *See KSR*, slip op. at 14. Here, the Examiner has failed to provide a rationale for combining the cited references. The Examiner's only explanation for combining the references is to simply identify the purpose of the element. For example, the Examiner's stated rationale for providing the transparent adhesive of *Smith* is "for the purpose of rendering invisible to the eye [t]o render the bandage inconspicuous". Likewise, the Examiner's rationale for combining the non-toxic pigment of *Dow* with *Carmody* is "to insure that the user is not poisoned by the pigment." However, these statements merely identify the purpose of each individual elements. They do not illustrate a suggestion, teaching, or motivation, to combine the elements.

Because *Carmody* does not disclose an absorbent pad, "having a non-toxic pigmented composition applied to it," or the step of, "applying a non-toxic pigment to the top side of the pad," applicant respectfully submits that *Carmody* does not suggest or disclose at least one element specifically required by independent Claims 1 and 7, and therefore, the Examiner fails to establish a *prima facie* case of obviousness against independent Claim 1 or Claim 7.

Claims 2-6 depend from Claim 1 and hence incorporate all the elements of Claim 1. Claim 2-6 are thus believed to be allowable for the same reasons set forth above with respect to Claim 1. Appellant thus requests that the Examiner's rejection of Claims 2-6 be reversed.

Claims 8-11 depend from Claim 7 and hence incorporate all the elements of Claim 7. Claims 8-11 are thus believed to be allowable for the same reasons set forth above with respect to Claim 7. Appellant thus requests that the Examiner's rejection of Claims 8-11 be reversed.

#### **D. Conclusion**

As discussed above, the references fail to disclose the noted elements of the claims, and hence, in accordance with the requirements of the MPEP, as set forth in Chapter 2100 the reference cannot make the claims obvious. Further, as noted above, in particular instances, the Examiner failed to make *prima facie* showings of obviousness or otherwise improperly interpreted or applied the disclosure of the cited patents.

As discussed above, Claims 1-11 are allowable over *Carmody*, *Dow*, and *Smith*, whether considered individually or in combination. Appellant thus respectfully requests that the Board reverse the Examiner's rejections of Claims 1-11.

## **VII. CLAIMS APPENDIX (37 CFR 41.37 (c)(1)(vii))**

The text of the claims in the appeal are:

1. (Original) A cosmetic bandage comprising:

a transparent backing layer having a top side and a bottom side;

a transparent adhesive layer applied to the bottom side of the transparent backing layer;

an absorbent pad having a bottom side and a top side, the top having a non-toxic pigmented composition applied to it so as to be derma matching and having a melanin likeness and appearance so as to substantially match human skin tones and colors, the top side of the absorbent pad being attached to the bottom side of said backing layer so as to be visible therethrough; and

at least one removable strip applied to the bottom side of said backing layer and said pad.

2. (Original) The bandage of claim 1 wherein the adhesive is pressure sensitive.

3. (Original) The bandage of claim 2 further including a plurality of removable strips.

4. (Original) The bandage of claim 3 wherein the pigmented portion comprises a plurality of pigments blended to provide skin matching capability.

5. (Original) The bandage of claim 3 wherein the pigments are imbedded in the pad.

6. (Original) The bandage of claim 3 wherein the pigments are coated on the pad.

7. (Previously presented) A method of constructing a cosmetic bandage comprising:

forming an absorbent pad having a bottom side and a top side;

applying a non-toxic pigment to the top side of the pad; and attaching the pigmented top side of the pad to a transparent backing layer.

8. (Original) The method of claim 7 further including the step of applying an adhesive to the backing layer prior to attaching the pad.

9. (Original) The method of claim 8 including the step of providing a removable and disposable strip over the adhesive layer.

10. (Original) The method of claim 9 including the step of applying the pigment to the pad by a silk screening process.

11. (Original) The method of claim 9 including the steps of applying the pigment by a flood printing process.

**IX. EVIDENCE APPENDIX (37 CFR 41.37 (c)(1)(ix))**

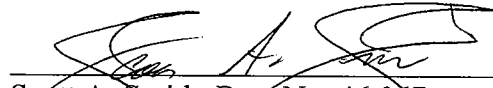
Not applicable.



**X. RELATED PROCEEDINGS APPENDIX (37 CFR 41.37 (c)(1)(x))**

Not applicable.

Respectfully submitted,



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